



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/716,467  | 11/20/2003  | Hans-Peter Mayer     | Q78456              | 6852             |
| 23373   | 7590        | 05/03/2004           | EXAMINER            |                  |
| SUGHRUE MION, PLLC<br>2100 PENNSYLVANIA AVENUE, N.W.<br>SUITE 800<br>WASHINGTON, DC 20037 |             |                      | HEALY, BRIAN        |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2874                |                  |

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Applicati n No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/716,467             | MAYER, HANS-PETER   |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Brian M. Healy         | 2874                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address --

**Peri d f r Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disp sition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Pri rity under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>042604</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

**FOREIGN PRIORITY**

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Europe on 12/03/2002

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

**102 REJECTIONS**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et. al., U.S. Patent Application Publication No.U.S. 2004/0013359A1

Lee et. al. teaches a planar waveguide duplex testing circuit (and method of making same) comprising: where the optical device in the form of plurality of cut or sawed optical fibers forming a plate (Note the fiber waveguides appear to be encased in a matrix material.) 2060,2030 that has a polished angled end facet 2050 with a deposited reflective filter layer on the facet with the optical device being placed in a recess that is adjacent planar waveguide 1140 and used to couple light signals in conjunction with an index matching material, which clearly, fully meets Applicant's claimed limitations.

Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Chun et. al., U.S.P. No.5,521,992.

Chun et. al. '992 teaches (Figs.1-5) a planar light wave circuit 400 that includes an optical device 408 provided in a recess 413, which clearly, fully meets Applicant's claimed limitations.

Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Gipson et. al., U.S.P. No.4,732,446.

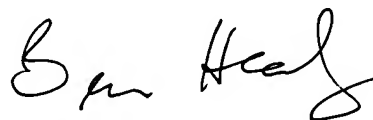
Gipson et. al., '446 teaches (Figs.1-15) a planar light wave circuit 10 that includes an optical device 32,40 provided in a recess 14 which clearly, fully meets Applicant's claimed limitations.

.Any inquiry concerning the merits of this communication should be directed to Examiner Brian M. Healy, Examiner at telephone number (571) 272-2344. Any inquiry of a general or clerical nature (i.e. a request for a missing form or paper, etc.) should be directed to the Technology Center 2800 receptionist at telephone number (703) 308-0956, to the technical support staff supervisor (Team 2) at telephone number (703) 308-3072, or to the Technology Center 2800 Customer Service Office at telephone number (703) 306-3329.

***BRIAN M. HEALY***  
***Primary Patent Examiner***  
***Group Art Unit 2874***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Duck et. al., U.S.P. No.6,438,291 (Figs.1-6), Marcuse et. al., U.S.P. No.5,966,478 (Figs.1-6), Norris et. al., U.S.P. No.4,878,696 (Figs.1-5) and Kashyap, U.S.P. No.6,094,291 (Figs.1-5).

All of the prior art documents submitted by applicant in the Information Disclosure Statement filed on 11/20/2003, have been considered and made of record. Note the attached initialed copy of form PTO-1449.

A handwritten signature in black ink, appearing to read "Brian Healy", written in a cursive style.

**Brian Healy**  
**Primary Examiner**